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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/735,613	12/16/2003	Shigeo Fukuda	FUKU3001/EM	2775

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EXAMINER

BERNATZ, KEVIN M

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 03/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/735,613

Applicant(s)

FUKUDA, SHIGEO

Examiner

Kevin M. Bernatz

Art Unit

1773

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 07 February 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: none.
Claim(s) objected to: none.
Claim(s) rejected: 6-10, 12 and 13.
Claim(s) withdrawn from consideration: none.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s), _____

13. ☒ Other: attached PTO-892

KMB

February 27, 2006

Continuation of 3. NOTE: the proposed amendment results in embodiments which were not previously considered (i.e. claims 7 - 10 did not previously require a FeNdB based magnet) and are not deemed to materially reduce or simplify the issues in the case.

Continuation of 11. does NOT place the application in condition for allowance because: applicants' arguments are directed to the unentered amendment. In so far as they apply to the rejection of record, applicants' argue the proposed amendment of a neodymium iron boron (NdFeB) magnetic would distinguish over the teachings of Sakurai et al., at least in terms of a rejection under 35 USC 102(b) (page 5 of response). The Examiner respectfully disagrees.

First, the Examiner notes that the proposed amendment has not been entered, and hence the arguments above are moot. Second, the Examiner notes that a genus teaching ("neodymium magnet") may still anticipate a specie (NdFeB) if there is sufficient specificity. In the instant case, the Examiner notes that NdFeB based "neodymium magnets" are the single most common/typical "neodymium" type magnets. E.g. see the wikipedia entry for Rare-earth magnet (attached). Therefore, the genus teaching of "neodymium magnet" in Sakurai et al. may still be sufficient for a rejection under 35 USC 102(b), or at the very least a rejection under 35 USC 103(a).

Applicants further argue that Sakurai et al. does not show spherical magnets (page 6 of response). The Examiner respectfully disagrees.

The Examiner notes that Sakurai et al. explicitly teach solid spherical magnets as suitable embodiments (see Figure 3a and Paragraphs 0002, 0005 and 0008). Also, the Examiner notes that applicants' present claims do not require that the spherical magnet consists of the rare-earth magnetic material, i.e. applicants' claims are open to other materials being included as part of the spherical magnets.

Finally, applicants argue that the Office has failed to establish a prima facie case of obviousness in view of the claimed species (page 7 of response). The Examiner respectfully disagrees.

Substitution of equivalents requires no express motivation as long as the prior art recognizes the equivalency. In the instant case, all rare-earth magnets are recognized as functional equivalents in the field of permanent magnets. Applicants have provided no evidence why one type of rare-earth magnet would be unexpectedly superior over any other rare-earth magnet, especially given that the disclosed field of endeavor is using the magnet as a fastener which is well within the knowledge of one of ordinary skill in the art. In re Fount 213 USPQ 532 (CCPA 1982); In re Siebentritt 152 USPQ 618 (CCPA 1967); Graver Tank & Mfg. Co. Inc. v. Linde Air Products Co. 85 USPQ 328 (USSC 1950).